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NORRIS, MCLAUGHLIN & MARCUS			EXAMINER	
875 THIRD AVE			KHAN, MEHMOOD B	
18TH FLOOR				
NEW YORK, NY 10022			ART UNIT	PAPER NUMBER
			2617	
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			01/06/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/550,914

**Applicant(s)**

DAFFNER ET AL.

**Examiner**

MEHMOOD B. KHAN

**Art Unit**

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09/25/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

- Claim 10 has been amended to be dependent from claim 1.
- Claims 15 and 16 are newly added claims.
- Claims 1-16 are currently pending.

### *Response to Arguments*

Applicant's arguments filed 9/25/2008 have been fully considered but they are not persuasive.

Applicant argues on pages 6 and 12 that "Laumen et al. discloses two MMS service providers each including an MMS Relay/server (e.g., RSA 2 or RSB 12), but fails to disclose or suggest an e-mail server, as claimed, much less that either of MMS Relay/Servers RSA or RSB (which the Examiner maintains is analogous to the claimed "push mail sever") is connected with an e-mail server for immediate delivery of e-mails received by the e-mail server to the communication terminal of the recipient."

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., an e-mail server...is connected with an e-mail server for immediate delivery of e-mails received by the e-mail server to the communication terminal of the recipient) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The Examiner would like to point out that Laumen clearly discloses the e-mails are forwarded from the e-mail server to a specially configured push mail server based on the e-mail address of the recipient (**0363, Fig. 4: 2, 12 & 11**). Laumen clearly

discloses a message received by RSA (**Fig. 4: 2, read as an Email server**) and forwarded to RSB (**Fig. 4: 12, read as push mail server**) and delivery from RSB to the user terminal (**Fig. 4: Deliver MM<sub>A</sub>, 11**). Laumen further discloses a receiving address in the message (**0363**).

Applicant argues on page 6 that "Therefore, there is no teaching or suggestion in either Laumen et al. or Gabriel et al. for a subscriber account being established for each subscriber on a push mail sever, wherein "the subscriber account including at least the telephone number of at least one telecommunication terminal and the original e-mail address of the recipient," as found in claim 2."

The Examiner respectfully disagrees. Gabriel is relied upon to disclose the subscriber account including at least the telephone number of at least one telecommunication terminal and the original e-mail address of the recipient (**0233**). Gabriel clearly discloses a subscriber account (**0233, recipient'snumber@managementserver.com**), since there is an email address, there is an account. Gabriel clearly discloses that the account includes a telephone number (**0233, recipient'snumber@managementserver.com**), the number is part of the email address. Furthermore, Gabriel clearly discloses "a user's account can also be set up to receive SMS messages via email" (**0234**).

Applicant argues on page 7 that "Accordingly, neither RSA 2 nor RSB 12 (which the Examiner maintains is analogous to the claimed "push mail sever") reads on the claimed "push mail sever" since neither receives an e-mail message nor encapsulates the e-mail message in a suitable content type for transmission via MMS or WAP."

The Examiner respectfully disagrees. Laumen clearly discloses a push mail server (**Figs. 1 & 4: 12**) where Laumen discloses push operation. Laumen clearly discloses that the transfer of the message between RSA and RSB occurs using Simple Mail Transfer Protocol (SMTP) (**0008**). Laumen clearly discloses encapsulation by sending the received message via the WAP message M-Retrieve.conf (**0041**).

Thus the limitations as claimed have been met.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Laumen et al. (US 2003/0086438 herein Laumen).**

Claim 12, Laumen discloses a device for immediate delivery of e-mails to a telecommunication device of a recipient via at least one telecommunication network (**Abstract, 0008, where Laumen discloses mail transfer protocol**), Laumen discloses with an e-mail server for transmitting the e-mails from a sender to the recipient (**0041, Fig. 4: 1 & 2, where Laumen discloses a sender (UAA) and a Relay/Server (RSA)**), Laumen discloses a telecommunication network including MMS or WAP push systems (**0041, Fig. 4: 2, 12 & 11, where Laumen discloses a UAB, MMS servers using WAP**), Laumen discloses a push server connected with the e-mail server for

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immediate delivery of the e-mails received by the e-mail server to the communication terminal of the recipient (**Fig. 4: 12 & 11, where Laumen discloses MMS servers**).

Claim 13, Laumen discloses wherein the telecommunication terminal is a mobile telecommunication terminal (**0006, where Laumen discloses a mobile radio**).

Claim 14, Laumen discloses wherein the telecommunication terminal is a landline telecommunication terminal (**0013, where Laumen discloses a computer**).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-8, 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laumen et al. (US 2003/0086438 herein Laumen) in view of Gabriel et al. (US 2004/0082348 herein Gabriel).**

Claim 1, Laumen discloses a method for immediate delivery of an e-mail to a telecommunication device of a recipient via at least one telecommunication network (**Abstract, 0008, where Laumen discloses mail transfer protocol**), Laumen discloses wherein the e-mail is transmitted from a sender via an e-mail server to the recipient (**0041, Fig. 4: 1 & 2, where Laumen discloses a sender (UAA) and a Relay/Server (RSA)**), Laumen discloses delivering the e-mail to a telecommunication

terminal of the recipient via conventional MMS or WAP push systems **(0041, Fig. 4: 2, 12 & 11, where Laumen discloses a UAB, MMS servers using WAP)**, Laumen discloses in that in that the e-mails are forwarded from the e-mail server to a specially configured push mail server based on the e-mail address of the recipient **(0363, Fig. 4: 2 & 12, where Laumen discloses receiving address in the message and sender-end RSA and recipient-end RSA)**.

Laumen does not explicitly disclose from where they are delivered to the telecommunication terminal based on a telephone number, which is included in the e-mail.

In an analogous art, Gabriel discloses from where they are delivered to the telecommunication terminal based on a telephone number, which is included in the e-mail **(0233, where Gabriel discloses sending the message to the intended recipient, after parsing the message)**. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Laumen by forwarding emails to devices based on addresses as taught by Gabriel so as to send messages to incompatible and distant cellular networks **(0007)**.

Claim 2, Laumen discloses the e-mail address of the recipient **(0347)**.

Laumen does not explicitly disclose wherein a subscriber account is established for each subscriber on the push mail server, the subscriber account including at least the telephone number of at least one telecommunication terminal.

In an analogous art, Gabriel discloses wherein a subscriber account is established for each subscriber on the push mail server **(0233, where Gabriel discloses account information)**, Gabriel discloses the subscriber account including at

least the telephone number of at least one telecommunication terminal **(0233, where Gabriel discloses a phone number)**. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Laumen to include account information and telephone numbers as taught by Gabriel so as to send messages to incompatible and distant cellular networks **(0007)**.

Claim 3, Laumen discloses wherein forwarding of the e-mail from the e-mail server to the push mail server is controlled by a device and by applying forwarding rules **(Fig. 4: 2 where forwarding of emails is based is done by a RSA)**.

Claim 4, Laumen does not explicitly disclose wherein the push mail server determines the telephone number of the telecommunication terminal of the recipient from the employed push mail address.

In an analogous art, Gabriel discloses wherein the push mail server determines the telephone number of the telecommunication terminal of the recipient from the employed push mail address **(0233, where Gabriel discloses parsing the address)**. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Laumen to include parsing the address as taught by Gabriel so as to send messages to incompatible and distant cellular networks **(0007)**.

Claim 5, Laumen discloses wherein the push mail server is connected to the MMS or WAP push systems of the employed telecommunication network **(Fig. 4: 2 & 12, where Laumen discloses a MMS-WAP push system)**.



Claim 6, Laumen discloses wherein the function of the push mail server is integrated directly in the existing e-mail server **(0006, 0007, Fig. 2: 2,12, where Laumen discloses that it is well known to have a relay and server as one configuration)**.

Claim 7, Laumen inherently discloses wherein the push mail server encapsulates the e-mail in a suitable content type, so that the e-mail can be transmitted via MMS or WAP push format **(0041, where Laumen discloses delivery using WAP)**.

Claim 8, Laumen discloses wherein a "message/rfc822" is employed as a content type **(0008, 0373, where Laumen discloses an email address)**.

Claim 10, Laumen discloses wherein a conventional WAP client or MMS client, which detects and processes encapsulated e-mails, is installed in the telecommunication terminal **(0041, where Laumen discloses an UAB at the terminal)**.

Claim 11, Laumen discloses wherein, if message units encapsulated with the special content type are detected, the e-mail contained therein is extracted and transmitted to the e-mail client of the telecommunication terminal **(0347, where Laumen discloses delivery via an email address)**.

Claim 15, as analyzed with respect to the limitations as discussed in claim 2.

Claim 16, as analyzed with respect to the limitations as discussed in claim 7.

**Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laumen in view of Gabriel in view of Ala-Luukko et al. (US 2003/0064706 herein Lukko).**

Laumen in view of Gabriel does not disclose wherein the push mail server includes a billing mechanism, which is used to produce toll tickets for the billing system of telecommunication network operators or other service providers.

In an analogous art, Ala-Luukko discloses wherein the push mail server includes a billing mechanism, which is used to produce toll tickets for the billing system of telecommunication network operators or other service providers **(0023, where Ala-Luukko discloses a billing tickets)**. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Laumen in view of Gabriel to include billing tickets as taught by Ala-Luukko so as to track message transactions.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MEHMOOD B. KHAN whose telephone number is (571)272-9277. The examiner can normally be reached on Monday - Friday 8:30 am - 5:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on 571-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mehmood B. Khan/  
Examiner, Art Unit 2617

/Lester Kincaid/  
Supervisory Patent Examiner, Art Unit 2617